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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/354,080	07/15/1999	MASSIMO BALESTRI	21197	4578

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EXAMINER	
KLIMACH, PAULA W	
ART UNIT	PAPER NUMBER
2135	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/354,080	BALESTRI ET AL.	
	Examiner	Art Unit	
	Paula W Klimach	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed on 08/09/04. Original application contained Claims 1-15. Applicant amended Claims 1, 3-8, and 11-14. The amendment filed on 08/09/04 have been entered and made of record. Therefore, presently pending claims are 1-15.

Response to Arguments

Applicant's arguments filed 08/09/04 have been fully considered but they are not persuasive because of following reasons.

Applicant argued that the combination of Wasilewski and Jardin would not yield the claim invention except if one ignored the pool of Jardin and the alternative method of coding the smart card in Wasilewski. This is not found persuasive. The combination presented by the examiner involves replacing the method of coding the smart card of Wasilewski with the method disclosed by Jardin. The result being that the algorithm for encoding the bit stream can be selected. This requires that the server of Wasilewski be modified to contain a pool of algorithms disclosed by Jardin (Jardin column 4 lines 19-33). The applicant argues further that the combination would not have been obvious at the time the invention was made from either reference. This is also not found persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347,

21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Wasilewski and Jardin was taken from Jardin (column 1 lines 47-59 in combination with column 2 lines 11-15).

Applicant argues that no teaching is present in Wasilewski or Jardin applied to Wasilewski regarding the possibility that each Entitlement Agent (Service Provider) may use different or respective algorithms. This is not found persuasive. The combination of Wasilewski and Jardin would include the capability of Jardin. This would be, as asserted by the applicant, the capability of modifying the use of one algorithm usable by the Wasilewski's modified server. Wasilewski's modified server would include the added capabilities of the pool of algorithms as disclosed by Jardin.

The applicant discloses that the application includes a user U chooses a particular provider. This has not been claimed.

The applicant argues further that the examiner has not explained why the ordinary skilled worker in the art would associate Jones with a smart card application. The definition of a smart card is a credit card that contains an integrated circuit that gives it a limited amount of intelligence and memory. The definition of a PCMCIA card (PC card) is a removable device, approximately the same size of a credit card, that is primarily used as a memory-related peripheral. The specific PCMCIA card utilized by Jones is contains authentication algorithms and therefore some intelligence. As a result, it has all the functionality that defines the smart card except the name.

The examiner asserts that Wasilewski and Jardin do teach or suggest the subject matter broadly recited in independent Claims 1 and 8. Dependent Claims 2-7 and 9-15 are also rejected

at least by virtue of their dependency on independent claims and by other reason set forth in this office action. Accordingly, rejections for claims 1-15 are respectfully maintained.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 1-3, 5-6, 8-10, and 12-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al (6,157,719) in view of Jardin (6,671,810).

In reference to claims 1 and 8, Wasilewski discloses a method for the controlled delivery of digital services to a user, wherein said services are identified by respective stream of encoded digital data emitted by said plurality providers (column 4 lines 20-23) and the user is provided with a receiver to receive said digital data streams from said plurality providers (Fig. 1), the receiver being selectively enabled to make use of determined services of a given provider (column 4 lines 41-50). The system includes a single removable user unit to be associated to said receiver for enabling the use of respective determined services of the provider (Fig.12 in combination with column 21 lines 15-27). An identifying code is incorporated into the digital data stream for the user to enabled to receive said determined services (column 4 line 64 to column 5 line 13). The single removable user unit is associated to a processing function capable

of security functions by exploiting said identifying code to enable the receiver of the user to make use of said determined services (column 5 lines 23-27).

Wasilewski does not expressly disclose incorporating into a digital data streams respective enabling algorithms to be selectively loaded into the smart card.

Jardin discloses downloading algorithms to a client application. The algorithm is used for secure communication. The server selects the algorithm from a pool of algorithms (column 4 line 40 to column 5 line 42).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the servers of Wasilewski to download the algorithm as is downloaded to the smart card of Jardin to the application where the application would be the smart card as disclosed by Wasilewski. One of ordinary skill in the art would have been motivated to do this because it would result in a system with almost an infinite number of security algorithms, which would make that system more secure (Jardin column 1 lines 47-59). The client would not require the specific knowledge of a particular algorithm (Jardin column 2 lines 11-15).

In reference to claims 2 and 9 wherein the single removable user unit is configured as a movable processing support uniquely assigned to the user (column 21 lines 11-14).

In reference to claims 3 and 10, wherein the single removable user unit configured as a smart card (column 21 lines 11-14).

In reference to claims 6 and 13 wherein the enabling algorithm is incorporated into a stream of private data within said data streams (Jardin column 3 lines 63-67).

In reference to claims 5 and 12, Wasilewski teaches of a system for conditional access where the service provider sends data streams in MPEG format, column 18, lines 32-35. The

receiver extracts the EMM message from the data stream, column 5 lines 9-13, where it stores the information from the EMM, therefore must extract the information. It uses a control word that includes authorization information from the EMM, therefore it interprets the identification code contained in the EMM message, column 4 lines 52-58. Waslewski teaches of an algorithm that generates the control word, which is used to decrypt the information, if the subscriber is entitled to watch the program, thus an enabling algorithm that is on the basis of the authentication information (identification code). Wasilewski teaches a smart card and therefore a removable algorithm

3. **Claims 7 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski and Jardin as applied to claims 3 and 13 above, and further in view of Spies (6, 055, 314).

Wasilewski and Jardin do not expressly teach the processor transmitting information about the delivery of the service itself.

The system described by Spies can be activated by the user unit to transmit information about the confirmation of the purchase request, thus about the delivery of the service.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to send information about the purchase as in Spies in the system of Wasilewski. One of ordinary skill in the art would have been motivated to do this because it would enable the system to carry out error checking and correct information that was not received correctly.

4. **Claims 4 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski and Jardin as applied to claims 1 and 8 above, and further in view of Jones et al (5, 623, 637).

Wasilewski and Jardin do not expressly disclose a system with a trusted middleware function in the reception means and a trusted middleware function in the dynamic part.

Jones discloses an embodiment of a system where trusted software carries out an authentication algorithm on the IC card (smart card) as well as on the host, column 8 line 13-34.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have a trusted middleware function in the static part (the host in the Jones system) and have a middleware in that dynamic part (the smart card). One of ordinary skill in the art would have been motivated to do this because the removable card allows data stored on the card to be made immediately available to the connected host computer, Jones column 2 lines 23-29.

5. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski and Jardin as applied to claim 8 above, and further in view of Kaplan et al (6,141,339).

Wasilewski and Jardin do not teach the use of Java cards.

Kaplan teaches of Java cards used to receive applets from service nodes, column 5 lines 59-61. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Java cards for the user unit. One of ordinary skill in the art would have been motivated to do this because Java applets provide the intelligence to support features, Kaplan column 5 lines 61-65.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK
Tuesday, April 19, 2005

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SUPERVISORY PATENT EXAMINER
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